

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 15039US02

PATENT

In the Application of:)	
)	
Jeyhan Karaoguz, et al.)	<u>Electronically Filed On January 13, 2010</u>
)	
Serial No.: 10/675,358)	
)	
Filed: September 30, 2003)	
)	
For: MEDIA PROCESSING SYSTEM)	
COMMUNICATING ACTIVITY)	
INFORMATION TO SUPPORT USER)	
INTERACTION DURING MEDIA)	
BROADCASTS)	
)	
Examiner: Duffield, Jeremy S.)	
)	
Group Art Unit: 2427)	
)	
Confirmation No.: 5972)	

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Paper responds to the Examiner's Answer mailed December 8, 2009. The Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-38 of the present application for at least the reasons set forth in the Appeal Brief and this Reply Brief.

REPLY BRIEF

The Applicants note that the Examiner's Answer sets forth essentially the exact same arguments as the Final Office Action. *Compare* Examiner's Answer at pages 3-14 with May 28, 2009 Office Action at pages 4-14. As such, the Appeal Brief addresses these arguments at pages 8-24. To the extent that the Examiner's Answer raises any new points, the Applicants will address below.

I. The Proposed Combination Of Finseth And Ellis Does Not Render Claims 1, 3-15, 24 And 26-32 Unpatentable

The Applicants first turn to the rejection of claims 1, 3-15, 24 and 26-32 as being unpatentable over Finseth in view of Ellis.

A. The Proposed Combination Does Not Render Claims 1 And 3-10 Unpatentable

As noted in the Manual of Patent Examining Procedure, "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." See MPEP at 2143.03 (emphasis added). Further, "[all words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." See *id.* (emphasis added).

However, the Examiner's Answer still does not show that the cited references describe, teach, or suggest **all the claim limitations**.

1. Notification of Consumption Based On A Match

As explained in the Appeal Brief, the Office Action contends that Finseth discloses “notifying the second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic,” as recited in claim 1. *See* Examiner’s Answer at page 4. The Applicants demonstrate that this contention is in error. *See* Appeal Brief at pages 10-18. Indeed, the Applicants even specifically address the specific portions of Finseth that the Office Action relies upon and demonstrate that they do not describe, teach, or suggest the relevant limitations. *See id.*

In response, however, the Examiner’s Answer essentially repeats its reasoning. *See* Examiner’s Answer at pages 14-17. The Examiner’s Answer simply repeats the same citations from Finseth, with the addition of “Col. 10, lines 13-36.” *See id.* at page 15. However, there is nothing in any of the portions of Ellis relied on by the Office Action that describes, teaches, or suggests “notifying the second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic,” as recited in claim 1.

The Examiner’s Answer is unable to point to anything in the cited references that describes, teaches, or suggests these limitations. Instead, the Office Action offers numerous subjective, **unsupported** statements as support for its contention. *See id.* at pages 15-17. For example, the Examiner’s Answer states that “[a]ll stored program characteristics that ‘match’ these user-selected characteristics are transmitted to the second user, thus ‘notifying’ the second user of the consumption of media.” *See id.* at page 15. Notably, the Office Action is unable to

provide any citation to support this statement. Instead, the Office Action merely offers conclusory statements. *See id.* The Examiner's Answer goes so far as to suggest that "transmission" is the same as "notifying." *See id.* However, a mere transmission of media is not the same as notifying one user of the consumption of media **by another**, as recited in the claims.

A rejection based on obviousness **"cannot be sustained with mere conclusory statements."** *See* the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Yet the Examiner's Answer is awash with such conclusory statements, as noted above. *See* Examiner's Answer at pages 14-17. For at least these reasons, and those set forth in the Appeal Brief, the Applicants respectfully request reconsideration of the claim rejections.

Additionally, claim 1 recites, in part, "notifying the second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic," as recited in claim 1. **The claim is clear that the media is requested.** The Applicants explain that Finseth does not describe, teach, or suggest **requesting** media. *See* Appeal Brief at pages 11-12, for example. **The Examiner's Answer agrees with this reasoning:**

Appellant states on Page 13, lines 21-22, as well as in multiple other instances that Finseth indicates that "the user selects which information to send, but not that another subscriber actually requests the information" ... **Examiner admits that this statement is correct.**

See Examiner's Answer at page 16 (emphasis in bold added, emphasis in underline in original). Accordingly, the Examiner's Answer contradicts its previous assertion that Finseth discloses

“notifying the at least one second user, via the communication network, of the consumption of the requested media by the first user....” *See id.* at page 4. The admission that Finseth does not describe, teach, or suggest such a request directly contradicts the argument in the Examiner’s Answer, and therefore, definitively demonstrates that the Examiner’s Answer and Office Action fail to establish a *prima facie* case of obviousness with respect to claim 1 or the claims depending therefrom

Curiously, however, the Examiner’s Answer also states that “there is nothing in the claims that states the second user has to request any characteristic information from another user.” *See* Examiner’s Answer at page 16.

Yet, as clearly shown above, claim 1 recites, in part, “notifying the second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic.” The claims clearly recite that the media is **requested**. The Examiner’s Answer relies on Finseth as disclosing this request. *See* Examiner’s Answer at page 4. However, the Examiner’s Answer also states that “Finseth indicates that ‘the user selects which information to send, but not that another subscriber actually requests the information’ ... **Examiner admits that this statement is correct.**” *See* Examiner’s Answer at page 16 (emphasis in bold added, emphasis in underline in original). This acknowledgement by itself shows that the Examiner’s Answer fails to establish a *prima facie* case of obviousness with respect to claim 1 or the claims depending therefrom. Thus, for at least these reasons, the Applicants respectfully request reconsideration of the rejection of claims 1 and the claims that depend therefrom.

Claim 1 recites “notifying the second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic,” as recited in claim 1. Thus, the **notification is sent if** the pre-defined set of characteristics for the requested media **matches** the at least one user-selected characteristic.

The Office Action states the following:

Appellant states on Page 17, lines 3-5, that Finseth does not teach “that delivery of viewing preference information from a first user to a second user is predicated on a match of any kind”, the examiner respectfully disagrees. Firstly, the claims do not state that the delivery of the preference information has to be predicated on a match.

See Examiner’s Answer at page 16.

However, as clearly shown in the Appeal Brief, that isolated portion, namely page 17, lines 3-5, is part of an analysis of the portions of Finseth that the Office Action (and Examiner’s Answer) specifically relies on, and demonstrates that the “viewing preference information from a first user to a second user,” which the Examiner’s Answer (and Office Action) seemingly subjectively conclude is the “notification,” is not predicated on a match of any kind.

The Examiner’s Answer, much like the Office Action, has not shown that any of the cited references describes, teaches, or suggests “notifying the second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic,” as recited in claim 1. Instead, the Examiner’s Answer lists a few isolated citations, but mostly unsupported, subjective, conclusory statements, which cannot sustain a rejection based on obviousness. A rejection based on obviousness “**cannot be sustained with mere conclusory**

statements.” See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Therefore, the Examiner’s Answer, much like the Office Action, has not shown that the prior art teaches or suggests **all the claim limitations**. Accordingly, the Examiner’s Answer and the Office Action fail to establish a *prima facie* case of obviousness with respect to claim 1 or any of the claims depending therefrom. See MPEP at 2143.03 (emphasis added).

2. Receiving A Media Request From The First User Via A Communication Network, Wherein The Media Request Relates To Media To be Sent Directly From The Second User To The First User

As noted in the Appeal Brief, in Ellis, the “stored video may be requested from the server, but not the contributor.” See Appeal Brief at page 19. Contrary to the assertion in the Examiner’s Answer, the first user in Ellis does **not** request media on demand directly from the second user. The Examiner’s Answer cites Ellis at column 10 as disclosing direct request of media from the user. However, as explained in the Appeal Brief, Ellis **actually** states that “Pressing a remote control OK key may direct the program guide to request the desired program from the **server or other equipment on which the program is stored.**” See Ellis at column 10, lines 18-20. There is nothing in Ellis at column 10, nor the remainder of Ellis, that describes, teaches, or suggests a direct request of media from one user to another. Again, the Examiner’s Answer points to nothing in the cited references that describes, teaches, or suggests “receiving a media **request from the first user** via a communication network, wherein the media request relates to media to be sent **directly via the communication network from the second user to**

the first user,” as recited in claim 1. Thus, for at least these reasons, the proposed combination does not render claims 1 and 3-10 unpatentable.

B. The Proposed Combination Of Finseth and Ellis Does Not Render Independent Claims 11 and 24 Unpatentable

Claim 11 recites, in part, “processing a **direct request** for media of another user, from the user, the media having a pre-defined set of characteristics; sending a notification via a communication network if the pre-defined set of characteristics for the **requested media matches** the at least one media characteristic; and refraining from sending a notification if the pre-defined set of characteristics for the requested media does not match the at least one media characteristic.” Independent claim 24 recites similar limitations. The Applicants respectfully submit that the proposed combination of Finseth and Ellis does not render claims 11, 24 or the claims that depend therefrom unpatentable for at least the reasons discussed above with respect to claim 1.

C. The Proposed Combination Does Not Render Claims 10 And 32 Unpatentable

The Applicants demonstrate that the proposed combination does not describe, teach, or suggest “keeping a record of the notifying [of the consumption of the requested media of the second user by the first user]; and the record being used by the second user to provide one or both of services and/or incentives to the first user,” as recited in claim 10, for example. *See* Appeal Brief at pages 20-21.

The Examiner’s Answer states, however, “When a first user shares viewing information with a second user, the data may be merged with the second user’s viewing information, i.e.,

keeping a record of the notifying ([Finseth at] Col. 11, lines 43-54, Col. 13, lines 1-29).” See Examiner’s Answer at page 18.

However, none of these cited portions of Finseth even remotely describes, teaches, or suggests **“keeping a record of the notifying [of the consumption of the requested media of the second user by the first user]; and the record being used by the second user to provide one or both of services and/or incentives to the first user,”** as recited in claim 10, for example. There simply is no mention of a record of notifying [of the consumption of the requested media of the second user by the first user] in any of the cited portions.

It is not enough for the Examiner’s Answer to subjectively equate a “record of notifying...” with the cited portions of Finseth, particularly when those cited portions clearly do not describe, teach, or suggest all the claim limitations. Again, a rejection based on obviousness **“cannot be sustained with mere conclusory statements.”** See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Thus, for at least the reasons set forth in the Appeal Brief at pages 20-21 and this section, the Applicants respectfully request reconsideration of the rejection of claims 10 and 32.

II. The Proposed Combination Of Finseth, Ellis And Lu Does Not Render Claims 2 And 25 Unpatentable

The Applicants respectfully submit that the proposed combination of Finseth, Ellis and Lu does not render claims 2 and 25 unpatentable for at least the reasons discussed above in Section I.

III. The Proposed Combination Of Lu, Finseth And Ellis Does Not Render Claims 16-23 And 33-38 Unpatentable

The Applicants demonstrate the proposed combination of Lu, Finseth and Ellis does not describe, teach, or suggest “server software that receives a **direct request**, from the first user for media from the second user, that identifies at least the associated first network address and media having at least one pre-defined characteristic, and that notifies, via a communication network, the associated second network address if the at least one media characteristic **matches** the at least one pre-defined characteristic.” *See* Appeal Brief at pages 21-24. Independent claim 33 recites similar limitations.

Notably, the Applicants explain in detail why the cited references do not describe, teach, or suggest the relevant limitations **by citing to actual portions of the references**. *See* Appeal Brief at pages 21-24, for example. However, the Response in the Examiner’s Answer simply offers numerous conclusory statements without any citations from the references. *See* Examiner’s Answer at pages 19-21. It is not enough for the Examiner to simply offer subjective, unsupported conclusions of what the Examiner wants the references to disclose in order to maintain the rejection. Instead, in order to establish a *prima facie* case of obviousness, the Examiner is required to base the analysis on what the references actually describe, teach, or suggest. Again, a rejection based on obviousness “**cannot be sustained with mere conclusory statements**.” *See* the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Thus, for at least these reasons, the Applicants respectfully request reconsideration of the rejection of claims 16-23 and 33-38.

IV. CONCLUSION

For at least the reasons discussed above, the Applicants respectfully submit that the pending claims are allowable. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-38.

The Commissioner is authorized to charge any necessary fees, or credit overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: January 13, 2010

/Joseph M. Butscher/
Joseph M. Butscher
Registration No. 48,326

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
(312) 775-8000; (312) 775-8100 (fax)